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10/812,589	03/30/2004	R. Bharat Rao	2003P04755US01	3220

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
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EXAMINER

PHONGSVIRAJATI, POONSIN

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3686

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,589	Applicant(s) RAO ET AL.	
	Examiner SIND PHONGSVIRAJATI	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-29, 31-33 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter.

3. Claims 1-29, 32-33 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter based on Supreme Court precedent, and recent Federal Circuit decisions, *In re Bilski U.S. Court of Appeals Federal Circuit 88 USPQ2d 1385*.

The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590.

4. The methods recited in claims 1-29, 32-33 are not tied to a machine nor transform the underlying subject matter to a different state or thing. See *Diamond v.*

Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); and Gottschalk v. Benson, 409 U.S. 63, 71 (1972).

5. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)).

6. A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-29, 32-33 fail to meet the above requirements because they are not tied to another statutory class of invention.

7. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal

or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

1. Claim 31 is rejected under 35 U.S.C. 101 because data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1-4, 8-25, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (US 4,491,725) in view of Rosen (US 6,513,025).

10. As to **Claim 1**, Pritchard teaches a method for processing medical information, comprising the steps of: receiving a medical claim from a health care provider which is to be submitted to a insurance company (Abstract, insurance company reads on “target payer”); automatically classifying the medical claim using a model that is trained to predict a disposition of the claim by the insurance company (col. 3 lines 31-38); and directing the medical claim for further processing based on the medical claim (col. 8 lines 18-30).

But Pritchard does not disclose the said model being a classification model. However, using a classification model is old and well known as evidence (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Pritchard to include the classification model of Rosen for the motivation for increasing the accuracy of the classification model (Rosen, col. 5 lines 6-9).

11. As to **Claim 2**, Pritchard teaches the method of claim 1, wherein the step of automatically classifying the medical claim comprises determining a probability of the medical claim being accepted or rejected by the insurance company (col. 7 line 67 to col. 8 line 10).

12. As to **Claim 3**, Pritchard teaches the method of claim 1, wherein the step of automatically classifying the medical claim comprises classifying the medical claim as accepted or classifying the medical claim as rejected and a basis for rejecting the medical claim (col. 8 lines 4-20).

13. As to **Claim 4**, Pritchard teaches the method of claim 3, wherein the medical claim can be classified as rejected as not covered by the payer (col. 7 lines 33-36).

14. As to **Claim 8**, Pritchard teaches the method of claim 1, wherein the step of directing the medical claim comprises sending the medical claim to the target payer if the medical claim is classified as being accepted (col. 8 lines 11-20).

15. As to **Claim 9**, Pritchard teaches the method of claim 1, wherein the step of directing the medical claim comprises sending the medical claim back to the provider if the medical claim is classified as being rejected (col. 8 lines 4-8).

16. As to **Claim 10**, Pritchard teaches the method of claim 1, wherein the step of directing the medical claim comprises automatically modifying the medical claim if the medical claim is classified as being rejected (col. 8 lines 4-8).

17. As to **Claim 11**, Pritchard does not specifically disclose the method of claim 1, further comprising automatically training a classification model of a target payer using training data derived from a history of past resolved medical claims associated with the target payer. Rosen does teach of providing a set of training data to an expert knowledge base and using machine-learning routines that teaches a classification model increase the accuracy of classification (Abstract, Fig. 1, col. 2 lines 45-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the disclosure of Pritchard to include training a classification model using training data for the motivation for increasing the accuracy of the classification model (Rosen, col. 5 lines 6-9).

18. As to **Claims 12, 17, and 18**, Pritchard does not specifically disclose the method of claim 1, wherein the training data further comprises domain-specific criteria in a domain knowledge base and wherein the classification model is trained to analyze one or more of a plurality of departments of the target payer or payers of the healthcare provider. Rosen does teach wherein the training data further comprises domain-specific criteria in a domain knowledge base and wherein the classification model is trained to analyze one or more of a plurality of sub-domains (col. 2 lines 63-65, col. 4 lines 2-9). It would have been obvious to one of ordinary skill in the art at the time of the invention to have the training data further comprises domain-specific criteria in a domain knowledge base and wherein the classification model is trained to analyze one or more of a plurality of departments and payers for the same motivation as claim 11.

19. As to **Claim 13**, Pritchard does not specifically disclose the method of claim 1, further comprising automatically updating a trained classification model associated with a target payer using data derived from final dispositions of medical claims by the target payer. Rosen does teach updating a trained classification model associated with any type of data set to derive an outcome based on the training set (col. 8 lines 29-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the disclosure of Pritchard to automatically updating a trained classification model associated with a target payer using data derived from final dispositions of medical claims for the same motivation as claim 11.

20. As to **Claims 14, 15, and 16**, Pritchard does not specifically disclose the method of claim 13, wherein automatically updating is performed continuously or periodically and automatically updating comprises re-training new classification model. Rosen does teach wherein automatically updating is performed continuously or periodically (col. 19 lines 11-13, col. 4 lines 45-48) and automatically updating comprises re-training new classification model (col. 8 lines 25-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to have updated the training records continuously or periodically and updating the new classification model for the same motivation as claim 11.

21. As to **Claim 19**, Pritchard teaches the method of claim 1, wherein the model is unique to the health care provider (col. 7 lines 46-59).

22. As to **Claim 20**, Pritchard teaches the method of claim 1, wherein the model is unique to the target payer (col. 5 lines 22-32).

23. As to **Claim 21**, Pritchard teaches the method of claim 1, wherein the model is unique to the healthcare provider/target payer relationship (col. 8 lines 25-41).

24. As to **Claim 22**, Pritchard teaches the method of claim 1, wherein the model is unique to one or more target payers in a geographical region (col. 4 lines 37-42).

25. As to **Claim 23**, Pritchard teaches the method of claim 1, wherein the classification model is unique to a medical domain (col. 4 lines 37-42).

26. As to **Claim 24**, Pritchard teaches the method of claim 1, wherein the step of automatically classifying the medical claim comprises predicting an expected final compensation for medical claims (col. 11 lines 14-18).

27. As to **Claim 25**, Pritchard teaches the method of claim 24, wherein the expected final compensation for the medical claims is provided as a distribution of compensations with associated probabilities (col. 11 lines 14-18, wherein the probabilities is 100%).

28. As to **Claim 32**, Pritchard teaches a method for processing medical information, comprising the steps of: receiving a plurality of medical claims from a health care provider that are to be submitted to one or more target payers (Abstract); and automatically predicting an expected cash flow for each medical claim (col. 9 lines 60-65), or a subset of the medical claims, using one or more models that are trained to predict a disposition of the medical claims by the one or more target payers (col. 5, lines 8-32).

But Pritchard does not disclose the said model being a classification model. However, using a classification model is old and well known as evidence (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Pritchard to include the classification model of Rosen for the motivation for increasing the accuracy of the classification model (Rosen, col. 5 lines 6-9).

29. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (US 4,491,725) in view of Rosen (US 6,513,025) in further view of Hammond et al. (US 5,613,072).

30. As to **Claim 33**, Pritchard teaches the method of claim 32, wherein automatically predicting an expected cash flow comprises: predicting an expected compensation for each medical claim (col. 9 lines 60-65), but the combination of Pritchard and Rosen does not specifically disclose predicting a resolution time for resolving each medical claim; and determining the expected cash flow associated with the medical claims by summing the expected compensation and resolution times for the medical claims. Hammond does teach predicting a resolution time for resolving each medical claim (col. 16 lines 27-37); and determining the expected cash flow associated with the medical claims by summing the expected compensation and resolution times for the medical claims (Fig. 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included predicting a resolution time for resolving each medical claim and determining the expected cash flow associated with the medical claims by summing the expected compensation and resolution times for the medical claims within the teachings of Pritchard and Rosen for the same motivation given in claim 33.

31. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (US 4,491,725) in view of Rosen (US 6,513,025) in further view of official notice.

32. As to **Claim 5**, the combination of Pritchard and Rosen does not specifically disclose the medical claim being classified as rejected for exceeding a maximum limit of the insurance company. However, it is well known in the art that insurance companies reject medical claims based upon the fact that the patient has exceeded their medical coverage limit for their policy, and official notice to that effect is hereby taken. For example, a auto insurance policy may have a policy liability limit of \$20,000 for a "per person" basis, the insurance company may reject a medical claim if the claim exceeds said liability limit amount. It would have been obvious to one of ordinary skill in the art at the time of the invention to have classified a claim as rejected based upon the target payer exceeding a maximum limit for the motivation for not paying more than the insured is entitled to for his/her coverage and meeting the requirements of the patient's insurance carrier (col. 8 lines 3-4).

33. As to **Claims 6 and 7**, the combination of Pritchard and Rosen does not specifically disclose the method of claim 2, wherein the medical claim can be classified as rejected for requiring further information or an attachment by the target payer and wherein the medical claim can be classified as rejected as including an incorrect combination of charges. However, it is well known in the art to reject a medical claim for requiring further information, for example, an insurance company may require disclosure to the medical procedure performed to ascertain whether the medical procedure was experimental. The status of the claim would remain rejected until further evidence is submitted. It is also well known to reject a claim based upon an incorrect

combination of charges, and official notice to that effect is hereby taken. It would have been obvious to one of ordinary skill in the art at the time of the invention to have rejected a medical claim for requiring further information and to reject a medical claim as including an incorrect combination of charges for the same motivation for not paying more than the insured is entitled to for his/her coverage and meeting the requirements of the patient's insurance carrier (col. 8 lines 3-4).

34. Claim(s) 26-29 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard (US 4,491,725) in view of Rosen (US 6,513,025) in further view of Beazley (US 2003/0149594).

35. As to **Claims 26-29**, the combination of Pritchard and Rosen does not specifically disclose wherein the step of automatically classifying further comprises predicting an expected time required to accept medical claims, including an expected time required to provide additional information, or an expected time to modify the medical claims and wherein the expected times are provided as a probability distribution with associated probabilities. Beazley does teach wherein the step of automatically classifying further comprises predicting an expected time required to accept medical claims, including an expected time required to provide additional information (paragraph 83, 101-105, and 123) wherein the expected times are provided as a probability distribution with associated probabilities (paragraphs 117-119). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included

predicting an expected time required to accept medical claims, where the expected times are provided as a probability distribution with associated probabilities within the disclosures of Pritchard and Rosen for the motivation for same motivation given in claim 1.

36. As to **Claims 30-31**, claims 30-31 substantially repeat similar limitations to claims 1-29 are rejected using the same rationale and reasoning.

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIND PHONGSVIRAJATI whose telephone number is (571) 270-5398. The examiner can normally be reached on Monday - Thursday 8:00am-5:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. P./
Examiner, Art Unit 3686
2 June 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
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